

13 stands rejected under the first combination above further in view of *Adobe Acrobat 3.0 Online Guide* (hereinafter "*Online Guide*"). Claims 6, 15-17, 19-21, 24-26, 28, and 29 stand rejected under the first combination above further in view of *Edupage Newsletter* (February 4, 1997)(hereinafter "*Edupage*"). Finally, claims 27 and 30 stand rejected as obvious in view of the aforementioned combination further augmented by "*HTML Tags at a Glance*" (hereinafter "*HTML Tags*"). The rejections will be discussed primarily by reference to the independent claims, which will be discussed in order.

Generally, each claim pertains to three entities: a document, a document model, and a thumbnail registered with the document model. Independent claim 1 recites:

A system for linking to a document, comprising:  
a **document model**, representative of the **document**, having a plurality of data structures representative of components within the document; and  
a **thumbnail image** registered with the document model such that selected coordinates within the thumbnail image are each mapped to a data structure selected from the plurality of data structures.

Thus the claim describes a document, a document model, and a thumbnail image, all in a cooperating relationship to one another.

As will be appreciated, a rejection for obviousness in view of a combination of references must meet three basic requirements. First, the combination of references must teach all of the claim elements. Secondly, there must be identified some teaching or suggestion to combine the references in the asserted manner. And thirdly, there must be identified some expectation that the asserted combination would be successful. See MPEP § 2143. Applicants' understanding of the asserted rejection of claim 1 is that an element of a "document" and an element of a "thumbnail image" are derived from *Martin*, which teaches the use of thumbnails in document image management. An element of a "document model" is taken from *FrameMaker*, the document model being an SGML representation of a document. In particular,

although it is not specifically cited in the Office action, *FrameMaker* states that “[w]hile the **document model** is that of SGML, the structure is presented in a graphical manner that spares the end user from dealing directly with SGML syntax.” (p. 1, emphasis added). (SGML or “Standard Generalized Markup Language,” is simply a mark-up language, and it finds use within other technologies such as HTML). It appears that the mark-up text is being cited as the “document model,” while the displayed presentation may be cited as the document itself.

It is respectfully submitted that a prima facie case of obviousness is not presented by the rejections of the pending claims for the reasons that (1) the cited combination of the references does not teach each and every claim element, (2) no objective teaching to combine the cited references in the asserted manner has been identified, and (3) no expectation of success in such a combination has been identified.

In particular, with respect to the first point above, claim 1 recites elements that are not found in the cited references. For example, the claim recites a thumbnail image that has a ***specified relationship*** to the document model, i.e. one that is “registered with the document model such that selected coordinates within the thumbnail image are each mapped to a data structure selected from the plurality of data structures.” In other words, the recited thumbnail image is one that has a registered relationship with the document model. As will be appreciated, the recited relationships between elements in a claim are themselves an important part of the claim and must similarly be found in the cited references for a prima facie case of obviousness to stand.

It is respectfully submitted that the “thumbnail image” of *Martin* is not one which is registered, or said to be registerable, with a document model, and that the document model of *FrameMaker* is not one with which any thumbnail is registered, or said to be registerable. These aspects of the claimed elements do not flow expressly or implicitly from any reference.

Accordingly, the recited elements of the claims are not found in the combination of cited references. It is therefore respectfully requested that the rejection of claim 1 be reconsidered and withdrawn.

Additionally, it is respectfully submitted that there is no teaching or suggestion to combine the cited references in the asserted manner. The asserted teaching to combine *FrameMaker* (SGML) with *Martin* (thumbnail) is that “using a document model as a means to select a particular data structure *would make sense* since it defines the structure of a document.” See Office action at p. 3, last paragraph. Thus, an important element of the claim, the relationship between the document model and the thumbnail image, is not supplied from any reference, but is rather simply said to “make sense.” It is respectfully requested that a reference be cited if possible to support the allegation that the claimed relationship between the thumbnail and the document model would have been obvious to one of skill in the art at the relevant time. That is, it is requested that a teaching to combine the references (a) at all, and (b) in a manner that would provide the claimed relationship be identified in a prior art reference, if the rejection is maintained. For the reason that there is no proper suggestion or teaching cited for the asserted combination of the cited references, it is respectfully requested that the rejection of claim 1 be reconsidered and withdrawn.

Finally, it is not clear what in the cited references indicates an expectation of success in making the asserted combination to arrive at the claimed combination of elements. Applicants respectfully submit that there is no expectation of success for the asserted combination to be found. For example, since *no* reference shows the recited unique characteristics of and *interrelationships* between any of the thumbnail image, the document model, and/or the document, it is not readily seen how an expectation of successfully creating such relationships and/or characteristics could be gleaned from the cited references.

Since the Office action does not address this required element of a prima facie case, it is respectfully requested that some citation be provided to specific art or to specific evidence of knowledge among those skilled in the art at the relevant time to demonstrate the required expectation of success. Although the law allows common sense and common knowledge to be relied upon to provide some element of the prima facie case, the Federal Circuit has confirmed that such is not legally proper unless actual evidence of the cited knowledge is also supplied. *See In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002). That is, an assertion that some element or combination stems from common knowledge is not itself evidence that the common knowledge is actually as alleged, and thus another form of evidence is still required. For the further reason that there is no expectation of success identified for the asserted combination of cited references, it is respectfully requested that the rejection of claim 1 be reconsidered and withdrawn.

Turning to independent claim 8, it is respectfully requested that the rejection of claim 8 is subject to the same traversals lodged with respect to claim 1, and therefore it is requested that the rejection of claim 8 be reconsidered and withdrawn. In particular, it is submitted that the asserted combination of references does not teach each element of claim 8, and that regardless, the combination is improperly made.

Claim 8 recites:

A method for registering a low-resolution thumbnail image with a document model having a plurality of data structures representative of components within a document, the method comprising the steps of:  
creating a full-sized bitmap image representative of the document;  
identifying coordinates within the full-sized bitmap image;  
mapping selected coordinates within the full-sized bitmap image to components selected from the document model; and  
reducing the full-sized bitmap image into the low-resolution thumbnail image.

This claim is even further from the prior art than claim 1. In particular, it requires a first leap of faith to suggest that the characteristics and interrelationships of the various system components (**thumbnail** is registered with document **model** used to access **document**) would have been obvious, and then a further leap that the method for creating those interrelationships would take the form recited in claim 8.

Thus, it is first respectfully suggested that the recited claim elements of claim 8 are not found in the prior art. In particular, the Office action expressly admits that the primary reference, *Martin*, does not teach either identifying coordinates within the full-sized bitmap image or mapping selected coordinates within the full-sized bitmap image to components selected from the document model. *See* p. 5. Although the Office action then goes on to detail the teaching of other references, there is no assertion that any reference actually teaches these missing claim elements. For this reason, it is respectfully submitted that a prima facie case of obviousness does not exist with respect to claim 8, and it is requested that the rejection of this claim be reconsidered and withdrawn.

Further, although the rejection of claim 8 is based upon a combination of several references, the Office action does not cite any objective teaching to combine the references. As discussed above, were the references even combinable to teach the invention, there must still be an objective and specific motivation cited to make the combination. For example, in the case of claim 8, the motivation to combine *GroupLab* and *Martin* appears to be that “[i]t would have been obvious to [combine *GroupLab* and *Martin*] since both *GroupLab* and *Martin* deal with the art of representing documents in image form to a user.” *See* p. 5.

However, if it were indeed true that *every* reference relating to “representing documents in image form to a user” was legally combinable with *every other* reference dealing with the same general issue, then there would only be one valid patent (if any at all) in the entire art of

“representing documents in image form to a user.” Clearly this is not the case, due to the fact that a specific teaching, suggestion or motivation to combine particular references is required by law for any rejection based on a combination of references. For the reason that no objective teaching to combine the cited references in the asserted manner has been identified, it is again respectfully submitted that a prima facie case of obviousness does not exist with respect to claim 8, and it is requested that the rejection of this claim be reconsidered and withdrawn.

Additionally, there has been cited no expectation of success in combining the cited references to achieve the recited combination of claim 8. If, as Applicant asserts, there is no objective teaching to combine the references in the asserted manner, then it will be difficult to nonetheless identify an objective expectation of success in doing so. Applicants respectfully submit that there is no expectation of success in combining the cited references to achieve the recited combination of claim 8, and accordingly request reconsideration and withdrawal of the rejection of claim 8.

Turning to independent claim 14, it is respectfully requested that the rejection of claim 14 is subject to the same traversals lodged with respect to claims 1 and 14, and therefore it is requested that the rejection of claim 14 be reconsidered and withdrawn. In particular, it is submitted that the asserted combination of references does not teach each element of claim 14, and that regardless the combination is improperly made.

Claim 14 recites:

A method for retrieving information from a document represented by a thumbnail image having coordinates registered with components selected from a document model representative of the document, the method comprising the steps of:  
sensing the position of a cursor over the thumbnail image;  
determining the coordinates within the thumbnail image corresponding to the sensed cursor position; and  
retrieving data from the document corresponding to the component from the document model registered with the determined coordinates.

It is first respectfully suggested that the recited claim elements of claim 14 are not found in the prior art. Given that the Office action indicates that the primary reference, *Martin*, does not teach either identifying coordinates within the full-sized bitmap image or mapping selected coordinates within the full-sized bitmap image to components selected from the document model (*See* p. 5), it would seem certain that *Martin* similarly does not teach a limitation such as “retrieving data from the document *corresponding to the component from the document model registered* with the determined coordinates [of a cursor]” as recited in claim 14 as well as the other related limitations of claim 14. As with the rejection of claim 8, the Office action then goes on to detail the teachings of other references, but there is no further assertion that any reference teaches the missing claim elements. For this reason, it is respectfully submitted that a prima facie case of obviousness does not exist with respect to claim 8, and it is requested that the rejection of this claim be reconsidered and withdrawn.

Further, regardless of whether the references are combinable to teach the invention, the Office action does not cite any objective teaching to combine the references. The motivation to combine *GroupLab* and *FrameMaker* and *SGML* to attempt to derive the limitations of claim 14 is that “[i]t would have been obvious to [combine *GroupLab* and *FrameMaker* and *SGML*] since *GroupLab* tries takes into account the document structure when selecting a focal point.” *See* p. 5. Even if that characterization of *GroupLab* is correct, the asserted teaching to combine amounts to no more than a bare statement of what *GroupLab* teaches, without any further reasoning or evidence as to why such teachings are obviously combinable with the other references.

For the reason that no objective teaching to combine the cited references in the asserted manner has been identified, it is again respectfully submitted that a prima facie case of

obviousness does not exist with respect to claim 14, and it is requested that the rejection of this claim be reconsidered and withdrawn.

Additionally, Applicants respectfully observe that there has been cited no expectation of success in combining the cited references to achieve the recited combination of claim 14. If the rejection of claim 14 based on a combination of references is to be maintained, it is respectfully requested that a citation to some objective expectation of success in making the combination be provided. Applicants respectfully submit that there is no expectation of success in combining the asserted references to achieve the recited combination of claim 14, and accordingly request reconsideration and withdrawal of the rejection of claim 14.

Turning to independent claims 18 and 22, these claims are rejected under the same rationales applied to claims 14 and 8 respectively. For the reasons set forth above with respect to claims 14 and 8, it is respectfully submitted that a prima facie case of obviousness has also not been presented with respect to claims 18 and 22. Accordingly, it is respectfully requested that the rejections of claims 18 and 22 be reconsidered and withdrawn.

Turning to claim 24, it is respectfully submitted that the rejection of this claim does not present a prima facie case of obviousness for the reasons that the cited combination of references does not teach the elements of claim 24, and that regardless there is no suggestion, teaching, or motivation in the art to combine the cited references in the asserted manner, nor any evidenced expectation of success in doing so. Indeed, as with the other claims in this application, a simple combination without further modifying the teachings of each reference would *not* have actually resulted in success. Claim 24 recites:

A hand-held computer, comprising:  
a memory adapted to store thereon a document model, representative of a document, the document model having a plurality of data structures representative of components within the document; and



a display adapted to display a thumbnail image registered with the document model and a word-at-a-time display;

wherein the thumbnail image is registered with the document model such that selected coordinates within the thumbnail image are each mapped to a data structure selected from the plurality of data structures; and

wherein the word-at-a-time display is adapted to display data represented by components selected from the document model in response to interaction with the thumbnail.

Claim 24 stands rejected under a combination of *Martin*, *GroupLab*, and *FrameMaker*, as asserted with respect to claim 1, further in view of *Tenax* software as discussed in *Edupage*. See Office action p. 10 asserting rejection of claim 24 under same grounds as stated for claims 1 and 6.

First, it is respectfully submitted that the asserted combination does not teach all elements of the claim for essentially the same reasons discussed above in the remarks regarding the rejection of claim 1. Moreover, the cited teachings to combine of *Martin*, *GroupLab*, and *Adobe* are respectfully traversed as legally insufficient as discussed above. Furthermore, there is no legally sufficient additional teaching identified to combine the teachings of *Edupage* with those of the other references. For example, the asserted teaching to combine is that “it would have been obvious to [combine *Edupage* with *Martin*, *GroupLab*, and *Adobe*] since the system [described by *Martin*, *GroupLab*, and *Adobe*] represents a document model consisting of text and other components registered with a thumbnail.” See Office action page 9.

Not only is this simply a bare statement of the alleged teachings of *Martin*, *GroupLab*, and *Adobe*, but also the alleged teachings themselves are not the *actual* teachings of the references combined or otherwise. Rather, it has been acknowledged that the described teachings are not contained in *Martin*, *GroupLab*, or *Adobe*, but are rather only said to be “obvious from” the references. And now, that leap is carried one leap further so that those inferred teachings are now being used to infer yet another non-taught teaching, i.e. to combine

*Edupage* with the other references. Thus, it is respectfully submitted that the asserted teaching to combine is in the best case simply a bare statement of the teachings of the *Martin/GroupLab/Adobe* conglomeration with no indication of any link or even relevance to the teachings of *Edupage*. More significantly, the asserted teachings do not even appear in the references themselves, but rather only appear in the Office action. Thus, for the reason that no objective teaching to combine the cited references in the asserted manner has been identified, it is respectfully submitted that a prima facie case of obviousness with regard to claim 24 has not been presented, and it is therefore respectfully requested that the rejection of claim 24 be reconsidered and withdrawn.

In addition, it is respectfully observed that no objective expectation of success in making the asserted combination has been identified. If the rejection of claim 24 over a combination of references is to be maintained, it is respectfully requested that a citation to some objective expectation of success in making the asserted combination be provided. It is respectfully submitted that there is no expectation of success in making the currently asserted combination, and accordingly, it is requested that the rejection of claim 24 be reconsidered and withdrawn.

With respect to dependent claims 2-7, 9-13, 15-17, 19-21, 23, and 25-30, it is respectfully submitted that these claims are allowable for the reasons discussed above with respect to their parent independent claims. Furthermore, for those dependent claims for which yet another level of obviousness is asserted, it is respectfully submitted that these supplemental obviousness assertions are legally insufficient as well. For example, with regard to claims 4 and 5, the assertion that it would have "made sense" to combine *W3C* with the other asserted references "since XML is a structured document," and "since the technology for including images and vector graphics in structured documents already existed," is simply an assertion that the references are combinable, and does not present any *teaching* to combine, let alone a legally

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acceptable teaching to combine. As discussed above, it is irrelevant under the law whether references are combinable when there is no teaching in the art to actually make the combination. As a further example, similar problems exist with respect to claims 15-17 and 19-21, and is respectfully submitted that there is similarly no legally cognizable teaching to support the supplemental combinations used to reject those claims.

The Drawings


Applicants acknowledge the Notice of Draftsperson's Patent Drawing Review. It is respectfully requested that the submission of formal drawings be deferred until such time as notice of allowance is received.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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